



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,372	12/23/2004	Michael J. Precopio	SU 103 US	4152
7590	08/23/2007		EXAMINER	
Henry E. Millson, Jr. 675 Golden Hawk Drive Prescott, AZ 86301-6623			LEVY, NEIL S	
			ART UNIT	PAPER NUMBER
			1615	
			MAIL DATE	DELIVERY MODE
			08/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/519,372	PRECPIO, MICHAEL J.
	Examiner	Art Unit
	NEIL LEVY	1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 June 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-9,11,13,15,16,18,20-26,33-36 and 45-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-9,11,13,15,16,18,20-26,33-36 and 45-63 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claim1, 3-9, 11, 13, 15, 16, 18, 20-26, 33-36 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is maintained; Norval (column 3, lines 60-63; column 4, lines 13-17) show benzylalcohol to attract some ectoparasites; ticks, while GANS shows it to be lethal to lice [0107] one would not know if any given compound would kill, attract, or repel, any given ectoparasite. LOVER shows lethality to mites, but not to lice, of 25% benzylalcohol, while 100% is lethal to both. Clearly, each species of ectoparasite, in each developmental stage, must be tested against each species of aralkyl on dose-response curves, in order to determine if any of the species besides benzylalcohol can meet the claim limitations of death of most ectoparasites. See example BESSETTE-US 2005/004233-Tables 2 [0185] and [0191] show 100% kill by benzylalcohol, but at [0197] only 60% kill in 10 minutes-species dependent effect. Additionally, efficacy is not predictable in the field from one analogue to the next (see, e.g., *In re PAPESCH* 137 USPQ 43, 48 quoting in *re SCHETTER* 98 USPQ 144, 150. We are convinced...that, as appellants contend, there is a considerable degree of unpredictability in the insecticide field with homologs, isomers, and analogs of known effective insecticides having proven ineffective as insecticides." Such experimentation required would be excessive.

Claim Rejections - 35 USC § 102

Claim45-48, 50-63 are rejected under 35 U.S.C. 102(b) as being anticipated by GANS et al US 2003/0040504.

Benzylalcohol [0021] is applied in gel or shampoo [0013] and kills eggs and lice [0014, 0022], and rinsed off with water [0016]. Repeated administrations are done; preferably 100% kill is obtained [0084]. Benzylalcohol is left on up to 20 minutes [0107] and is at 0.5-20% [0108]. Exemplary air impermeable compositions are shown as VI, XII.

Claim Rejections - 35 USC § 103

Claim1, 3-9, 11, 13, 15, 16, 18, 20-26, 33-36, 45-63 stand rejected under 35 U.S.C.

103(a) as being unpatentable over Lover 4368207 and Bessette 6974584 and Cardin et al 5288483, in view of Pearlman 6303581.

Note CARDIN works the compositions into the scalp and hair ((b) of column 12), the instant "sufficient to saturate" then rinsed with water (column 7, lines 5-11).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1,3-5,8,9,13,18,20,22-26,33 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim28,29,31-38. Patent No. 6793931.

Claims 1,3 –5,8,13,15,16,18,20,22-26,33,stand are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 33-38,44-46,48-51,65-81 of US application # 10,/382188.

Claims 1,3-5,8,13,15,16,18,20 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 30,32-36,38,45,47,49,51,54,56,58 & 60 of copending Application No. 10336457.

Response to Arguments

Applicant's arguments filed 6/4/07 have been fully considered but they are not persuasive; applicant argues claims are enabled. However, see rejection as maintained, with references to support the species specific effects of specific compounds.. As to the 103 rejection, arguments that the art cited does not show Benzylalcohol to be preferred, nor does each of the references show Benzylalcohol in a suffocating composition, with 99% efficacy. In fact, references are said to teach away. However, examiner finds the art shows a number of alcohols to be effective and safe, thus, useful as combined for lice control. The declaration is beyond the scope of the claims.

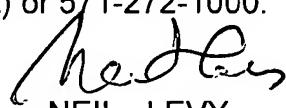
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



NEIL LEVY
Primary Examiner
Art Unit 1615
